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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 47079-00086USPT

	Application Number	Filed
	09/821,195	March 29, 2001
	First Named Inventor: Timothy C. Loose et al.	
	Art Unit: 3712	Examiner: Robert E. Mosser

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 48,655
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

Cynthia K Thompson
Signature

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May 10, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[x] *Total of 3 forms are submitted.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 284724253 US, on the date shown below, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 10, 2006 Signature: Cynthia K Thompson (Cynthia K. Thompson)

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/821,195
Applicants	:	Timothy C. Loose, et al.
Filed	:	March 29, 2001
Title	:	Gaming Machine With An Overhanging Touch Screen
TC/A.U.	:	3714
Examiner	:	Robert Mosser
Docket No.	:	47079-00086
Customer No.	:	30223

CERTIFICATE OF MAILING

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Signature: Cynthia K Thompson
Cynthia K. Thompson

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After Final
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Commissioner:

The Final Office Action was mailed on January 10, 2006, and the shortened time period to respond is April 10, 2006. This Pre-Appeal Brief Request for Review is being filed May 10, 2006, together with a Petition for Extension of Time to May 10, 2006.

REMARKS

Claims 1-3 and 5-10 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,769,716 ("Saffari") in view of EP0789338 ("Bruzzese"). Claims 4 and 11 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Saffari, Bruzzese, and further in view of U.S. Pat. No. 5,033,744 to Bridgeman ("Bridgeman").

1. Applicants Have Been Given No Fair Opportunity To Respond to the Rejections

Before addressing the substance of the rejections, the procedural abnormalities of this application are worth noting. In a Response To Final Office Action, the Applicants argued that the video portion displaying "a plurality of symbols indicating a randomly selected outcome of a wagering game" put the claim in condition for allowance. *See* March 10, 2006 Response To Final Office Action, p. 5. In response to this argument, the Examiner attempted to clarify how

Bruzzese also taught that the reel portion **could be** a video display. Advisory Action, March 29, 2006, p. 3. By making this argument for **the first time in an Advisory Action**, the Applicants have not been given a fair opportunity to address this argument.

Additionally, the Applicants first submitted claim 11 in their December 6 2005 Amendment With RCE. The Examiner responded to **new** claim 11 with a final rejection. *See* January 10, 2006 Final Rejection, p. 5. Such a final rejection is only proper when "all claims of the new application (1) are drawn to the same invention claimed in the earlier application, ... " MPEP § 706.06(b). Claim 11 is **not** drawn to the same invention claimed in the earlier application as it includes limitations different from the limitations of the pending claims. For example, claim 11 requires "each of said second indicia being illuminated independently of other second indicia." This limitation was not included in any prior claim and had not previously been reviewed by the Examiner. Therefore, because claim 11 was drawn to a different invention than the previous claims, the Examiner improperly finally rejected **new** claim 11 in a first action.

Even if claim 11 were determined to be the same invention as the prior claims (which it is not), the citations to Bridgeman were ambiguous at best and the Applicants deserved to understand the Examiner's arguments prior to a final office action. In the January 10, 2006 Final Office Action, the Examiner cited to col. 5, l. 68-6:2 and FIG. 2 of Bridgeman for disclosing multiple light circuits capable of individually lighting the buttons. However, as Applicants pointed out in the Response After Final, FIG. 2 actually shows a **single** light circuit. Other portions of the specification of Bridgman also support Applicants' position. In the Advisory Action, the Examiner **admitted** that "the evidence provided by the Applicant does support the conclusion of at least one light circuit," thereby acknowledging that Bridgeman was ambiguous on this point. March 29, 2006 Advisory Action, p. 6. Because of this ambiguity, **new** claim 11 should not have been **finally** rejected based upon Bridgman in a first action.

2. THE EXAMINER'S RELIANCE ON BRUZZESE'S BACKGROUND IS MISPLACED

The Advisory Action states that Bruzzese's reel portion can be a video display. Advisory Action, p. 3. It relies on Bruzzese's "Background" section for this teaching. However, when read in its entirety, Bruzzese teaches away from using a video display. Bruzzese states that utilizing video monitors creates "difficult technical problems associated with bonding touch screen controllers to curved video monitor screens." Bruzzese, col. 1, ll. 30-32. The "Background" section goes on to state that there is still "a significant demand amongst players of

gaming machines for the older-style spinning reel machine," and, therefore, Bruzzese is directed to a mechanical spinning reel game. *Id.* at ll. 38-42.

Without question, Bruzzese is focused on a new wagering game that includes a touch screen and **mechanical spinning reels**. Bruzzese provides an unequivocal teaching that the randomly selected outcome of the wagering game is **not** to be displayed utilizing a video display, but on mechanical spinning reels. *Id.* at 30-42. The skilled artisan would not modify Bruzzese's basic teaching to arrive at the present invention because to do so would change the principle of operation and render Bruzzese unsatisfactory for its intended purpose. MPEP §2143.01.

3. SAFFARI AND BRUZZESE FAIL TO DISCLOSE EVERY ELEMENT OF CLAIM 1

The combination of Saffari and Bruzzese also fails to disclose all of the elements of claim 1. Specifically, the combination fails to disclose "a unitary touch screen overlapping both said video portion and said non-video portion," wherein the video portion "displays a plurality of symbols indicating a randomly selected outcome of a wagering game."

The Examiner **admits** that Saffari is silent regarding the incorporation of a unitary touch screen across both a video portion and a non-video portion. *See* January 10, 2006 Final Office Action, p. 4. Bruzzese discloses a touch screen 34 and a graphical display 38. The touch screen 34 of Bruzzese **does not overlay a video display that displays a plurality of symbols indicating a randomly selected outcome of the game, as required by claim 1**, because there is **no** video display in Bruzzese for displaying the randomly selected outcome. Bruzzese's graphical display 38 provides the player with game information, credits, and/or advertisements. Bruzzese, col. 3, ll. 27-31. Quite differently, Bruzzese utilizes the mechanical reels 18 located away from the graphical display 38 to display the random outcome. Thus, there is no teaching in Saffari and Bruzzese of a touch screen that overlays a non-video portion and a video display that displays a plurality of symbols indicating the random outcome of the game.

The Panel is invited to review the detailed arguments at pp. 5-6 of the Reply to Final.

4. THE EXAMINER'S POSITION ON BRIDGEMAN IS IN ERROR

Claim 11 requires that the "second indicia are **selectively** illuminated by lights" to indicate which of said second indicia are active and selectable by the player and that each of the second indicia are "illuminated **independently**" of each other. The Examiner admits that Bruzzese and Saffari fail to disclose these limitations, and relies on Bridgeman for this feature.

The Examiner now admits that there is an ambiguity as to whether Bridgeman discloses a single light circuit 238 for all of the buttons, or multiple light circuits 238 with one circuit being associated with each button 236. Advisory Action, p. 6. More evidence supports the Applicants' position that there is a single light circuit 238 -- (i) FIG. 2 has only **one** box to illustrate the light circuit 238 driven by the drive circuit 226 (not multiple boxes), (ii) FIG. 2 refers to this item as a "light circuit 238" (singular), and (iii) the listing of the drawing reference numerals indicates "238" is a **single** light circuit, not multiple light circuits. Bridgeman, col. 4, l. 11. The Examiner can only rely on one sentence to support the notion of multiple light circuits 238.

Beyond the preponderance of the evidence suggesting there is only one light circuit 238, the Examiner can find **no** support in Bridgeman for "second indicia that can be illuminated independently of other second indicia." So, the Examiner attempts to rely upon an **implicit** teaching of this element in FIG. 4. Advisory Action, p. 6. Yet, FIG. 4 is simply a flow diagram showing how the game is played. There is absolutely no indication in FIG. 4 that the lights associated with buttons 56, 58, 60, 62 are selectively illuminated. FIG. 4 indicates when the player activates the buttons, not that the button lights are selectively illuminated. It is equally plausible that **all** lights for buttons 56, 58, 60, or 62 are illuminated once the player has inserted coins at step 402 as the game is about to begin and **all** buttons are ready to accept input.

The Examiner seems to suggest that selective illumination of lights is needed for feedback for the player. Yet, just after the statement the Examiner relies up on at Col. 5, line 68 to Col. 6, line 2, Bridgeman teaches that a sound generator 240 signals a button's activation by a player. There is **nothing** stating that the lights in the buttons provide this signaling to the player.

More importantly, the Examiner mentions the exclusive function of the buttons at Col. 5, lines 6-13. Yet, this section supports the Applicants' position. Here, Bridgeman teaches that the deal button 58 and the freeze button 60 can be combined into one button because they are used at different times. Considering the Examiner's position that each button 56, 58, 60, 62 is **only** lit when it is ready to accept input, *e.g.*, after the player actuates the combined deal/freeze button to "deal" the cards, the light for that button would be "off." Yet, if that is the case, and the player wants to end the game by activating the "freeze" button, then the light on the combined deal/freeze button would still be "off" (*i.e.*, it would not be lit to indicate it is ready to accept input as the "freeze" function). Thus, this section does **not** suggest that the lights for the buttons

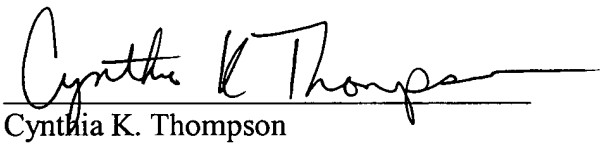
should be "selectively illuminated" when they are ready to receive input – it suggests the opposite.

A *prime facie* case of obviousness has not been established for claim 11 as there is no teaching that the lights of the second indicia are "selectively illuminated" and "illuminated independently." The Examiner relies on an **implicit** teaching derived from a strained reading of Bridgeman, while ignoring other statements that cut against the Examiner's position.

6. CONCLUSION

It is the Appellants' belief that all of the claims are patentable and are in condition for allowance, and action towards that end is respectfully requested. It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00086USPT.

Respectfully submitted,



May 10, 2006
Date

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